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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/081,776

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James M. Barton

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10/19/2007

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2055 GATEWAY PLACE

SUITE 550

SAN JOSE, CA 95110

EXAMINER

NGUYEN, HUY THANH

ART UNIT

PAPER NUMBER

2621

MAIL DATE

DELIVERY MODE

10/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/081,776

Applicant(s)

BARTON ET AL.

Examiner

HUY T. NGUYEN

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-28 and 48-110 is/are pending in the application.
- 4a) Of the above claim(s) 59-110 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-28 and 48-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/18/07, 9/19/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 20-28 and 48-48 is withdrawn in view of the newly discovered reference(s) to Shore et al. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 20-25 and 48-53 are rejected under 35 U.S.C. 102(e) as being anticipated by Shore et al (6,353,461).

Regarding claims 20 and 48, Shore et al (6,353,461 B1) discloses a process and an apparatus (Fig. 1) for a digital video recorder, comprising the steps of storing a plurality of multimedia programs in digital form on a storage device (page 3) ; displaying a list of previously recorded multimedia programs stored on said storage device to a user(column 2, column 4, lines 1-17, column 9, lines 1-15),

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wherein the user selects previously recorded multimedia programs from said list; simultaneously playing back at least one of selected segments of previously recorded multimedia programs and a multimedia program whose storage is in progress (Abstract, column 4, lines 1-17, column 9, lines 1-15, column 15, lines 14-20); and output means for output the recorded playback segments and the segments that the storage being progressed (column 15, lines 14-21) .

Shore further teaches that the playing back step allows playback rate and direction of each multimedia program to be controlled individually and simultaneously to perform any of: at least a fast forward, and rewind frame step, pause, and play functions (Fig. 7, column 10, lines 34 to column 11, lines 1-35).

Regarding claims 21 and 49, Shore further teaches the playing back step converts said at least one of said selected multimedia programs and said multimedia program whose storage is in progress into display output signals (column 4, lines 1-17).;

Regarding claims 22 and 50, Shore further the process of Claim 21, further comprising the step of inserting on-screen displays into a display output signal (Fig. 7).

Regarding claims 23 and 51, Shore further, wherein a user controls the playback rate and direction of a multimedia program through a remote control (Fig 7, column 4, lines 1-15, column 10, line 36 to column 11, line 35).

Regarding claims 24 and 52, Shore further teaches providing a multimedia recording device, wherein said playing back step sends a multimedia program to said

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multimedia recording device, allowing a user to record said multimedia program (column 18, lines 50-65).

Regarding claims 25 and 53 , Shore further teaches the step of:
providing editing means for creating custom sequences of video and/or audio output;
and wherein said editing means allows any number of video and/or audio segments of
multimedia programs to be lined up and combined and stored on said storage device
(column 15).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 26 –28 and 54-58 rejected under 35 U.S.C. 103(a) as being unpatentable over Shore in view of Browne et al (WO 92/22983).

Regarding claims 26 and 54, Shore fails to teach using tuners for inputting program. Browne teaches the process of Claim 20, further comprising the steps of providing a plurality of input signal tuners; wherein said tuners accept analog and/or digital multimedia program signals; wherein each of said tuners is individually tuned to a specific multimedia program; and converting analog multimedia programs into a digital representation (Fig. 1).

It would have been obvious to one of ordinary skill in the art to modify Shore with Browne by using the teaching of Browne to providing tuners as alternative to the input devices of Shore.

Regarding claims 27 and 55, Shore as modified with Browne further teaches the step of providing means for synchronizing video and audio components for proper playback (See Browne, Fig. 3).

Regarding claim 28 and 56, Shore as modified with Browne further teaches an input signal tuner receiving data.

Regarding claim 57, Shore as modified with Browne further teaches, wherein said playing back step plays back said at least two of said multimedia programs in a picture in a picture format to a display device (See Browne page 21).

Regarding claim 58, Shore as modified with Browne further teaches the playing back module plays back said at least two of said multimedia programs in a picture in a picture format to a display device (page21).

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY T. NGUYEN whose telephone number is (571) 272-7378. The examiner can normally be reached on 8:30AM -6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

H.N

HUY T. NGUYEN
PRIMARY EXAMINER